

Applicants: J.M. Nuss et al.

Attorney Docket No.: 1647.002

Application No.: 09/738,066

Group Art Unit: 1624

Filed: December 15, 2000

Examiner: T.N. Truong

Title: BICYCLIC INHIBITORS OF GLYCOGEN SYNTHASE KINASE 3

Seattle, Washington 98101

February 27, 2004

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TO THE COMMISSIONER FOR PATENTS:

RESPONSE TO PAPER NO. 20

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Applicants respectfully traverse the restriction requirement which the Office issued pursuant to M.P.E.P. § 806.04 and § 808.01 on October 30, 2003.

Applicants submit that the pending claims are manifestly generic under M.P.E.P. § 806.04(d). As stated at page 4 of the October 30, 2003 Office Action, the claimed compounds share the same core, that is, each of the independent Claims 1 and 35 "include[s] no material element additional to those recited in the species claims" and "comprehend[s] within its confines the organization covered in each of the species." M.P.E.P. § 806.04(d).

Moreover:

Once a claim that is determined to be generic is allowed, all of the claims drawn to species in addition to the elected species which include all the limitations of the generic claim will ordinarily be obviously allowable in view of the allowance of the generic claim, since the additional species will depend thereon or otherwise include all the limitations thereof. M.P.E.P. § 806.04(d).

The present prosecution history indicates that the generic claims in substantially their present format were searched and examined in connection with the Office Action dated October 10, 2001, and that the Office subsequently allowed the generic Claims 1 and 35 on April 4, 2002. Thus, applicants submit that the mandate against restriction in the above-quoted

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fourth paragraph of M.P.E.P. § 806.04(d) expressly applies to the pending claims and present disposition of the subject application.

In entering the restriction requirement, the Examiner apparently relied on M.P.E.P. § 806.04 and the first sentence of M.P.E.P. § 808.01 as a basis for stating that inventions are unrelated if it can be shown that they are not capable of use together and have different modes of operation, different functions, or different effects [emphasis added]. It is noted, however, that the Examiner has not articulated any fact(s) to support her conclusion that the claimed compounds have different modes of operation, different functions, or different effects. To the contrary, the subject specification itself discloses that the claimed compounds have the same operation, function, and effect: that of inhibiting the activity of GSK-3 *in vivo*.

Since the claims of the present application have already been searched, examined and found to be allowable in substantially their present form, mandating restriction at this point in the prosecution history serves only to place a substantial undue burden on the applicants.

For the foregoing reasons, applicants respectfully request reconsideration and withdrawal of the requirement.

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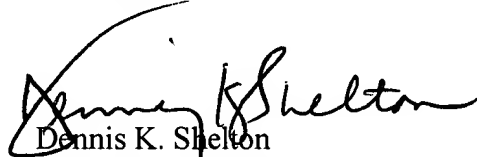
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Election

Subject to 37 C.F.R. § 1.143 and the foregoing request for reconsideration, the applicants hereby elect the subject matter of the Examiner's Group III for further prosecution, which invention shall be the one elected in the event the requirement becomes final.

Respectfully submitted,

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Date: 2/27/2004



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